

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAR 08 2006

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BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD FRANCIS MCBREARTY, SHAWN PATRICK MULLEN,
JOHNNY MENG-HAN SHIEH and MICHAEL WILLIAM WORTMAN

Application No. 09/801,612

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on February 2, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

A review of the file indicates that the appeal brief filed July 25, 2005 and the examiner's answer mailed October 11, 2005 have used the format set forth in 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on September 13, 2004, and replaced

by 37 CFR § 41.37(c). Accordingly, the appeal brief filed on July 25, 2005 and the examiner's answer mailed October 11, 2005 does not comply with 37 CFR § 41.37(c).

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not

permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c) (1) (ii) of this section.

A review of the application indicates that the following appropriate sections are missing from the appeal brief filed July 25, 2005 and the examiner's answer mailed October 11, 2005:

- 1) "Summary of claimed subject matter" as set forth in 37 CFR § 41.37(c) (1) (v);
- 2) "Grounds of rejection to be reviewed on appeal" as set forth in 37 CFR § 41.37(c) (1) (vi);
- 3) "Evidence appendix" as set forth in 37 CFR § 41.37(c) (1) (ix); and
- 4) "Related proceedings appendix" as set forth in 37 CFR § 41.37(c) (1) (x).

A substitute appeal brief and a revised examiner's answer that is in compliance with 37 CFR § 41.37 are required. For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Application No. 09/801,612

Also, On December 12, 2005, appellants filed a reply brief in response to the Examiner's answer mailed October 11, 2005. However, there is no indication on the record whether or not the examiner has responded to the reply brief. Section § 1208.03 of the Manual of Patent Examining Procedure (8th ed., Aug. 2001) states:

[A]ppellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer. . . . The primary must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution to respond to the reply brief. See MPEP § 1208.02 [emphasis added].

Accordingly, it is

ORDERED that this application be returned to the examiner to: 1) hold the appeal brief of July 25, 2005 defective; 2) request appellants to file a substitute appeal brief in compliance with 37 CFR § 41.37; 3) vacate the examiner's answer and provide a revised examiner's answer in accordance with the new rules effective September 13, 2004 in response to the substitute appeal brief; 4) for proper response to the reply brief filed December 12, 2005; and 5) for such further action as may be appropriate.

Application No. 09/801,612

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of this appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
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